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10/726,273

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. CZAYKA,
CARLOS VARGAS-ABURTO, and ROBERTO M. URIBE

Appeal 2009-003319
Application 10/726,273
Technology Center 1700

Decided:¹ June 19, 2009

Before EDWARD C. KIMLIN, CATHERINE Q. TIMM, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2-4, 10-14, and 19-

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

30. We have jurisdiction under 35 U.S.C. § 6(b).

Claims 2 and 19 are illustrative:

2. A method of making a thickened compound comprising:

preparing a composition consisting essentially of at least one unsaturated oligomer resin, and at least one unsaturated monomer, and

non-reversibly, partially crosslinking said composition a predetermined amount by irradiation to provide a stable, partially crosslinked composition, wherein the viscosity of said composition is increased and further wherein the partially crosslinked composition is capable of being further crosslinked.

19. A molding compound consisting essentially of:

at least one unsaturated oligomer resin;

at least one unsaturated monomer; and

optionally, at least one free radical initiator;

wherein said compound is non-reversibly crosslinked by irradiation within a predetermined amount to provide a stable, partially crosslinked compound, and wherein the partially crosslinked compound is capable of being further crosslinked.

The Examiner relies upon the following references in the rejection of the appealed claims (Ans. 3):

Parker (hereafter Parker '544)	3,300,544	Jan. 24, 1967
Parker (hereafter Parker '950)	3,429,950	Feb. 25, 1969
Mitani	4,327,145	Apr. 27, 1982
Lane	5,985,785	Nov. 16, 1999
Mathur	6,063,864	May 16, 2000
Miwa (as translated) (hereafter JP '675)	JP 54120675A	Sept. 19, 1979

Appellants' claimed invention is directed to a method of making a thickened compound from a composition consisting essentially of at least one unsaturated oligomer resin, at least one unsaturated monomer and, optionally, a free radical initiator and various other additives. The method entails partially crosslinking the composition with irradiation.

Appealed claims 19-26 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Mitani or Parker '950. Claims 19-26 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker '950 in view of Parker '544, JP '675 and JP '791. Claims 2-4, 10-14, and 19-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitani or Parker '950 in view of Mathur, Lane, or JP '675.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter is unpatentable over the cited prior art. Accordingly, we will sustain the Examiner's rejections for essentially those reasons expressed in the Answer.

Concerning the § 102 / § 103 rejections of claims 19-26 over Mitani and Parker '950, there is apparently no dispute that both references describe a composition comprising an unsaturated oligomer resin and an unsaturated monomer that is non-reversibly crosslinked by irradiation to produce a partially crosslinked compound. The principal issue on appeal is whether the "consisting essentially of" language of the claims excludes from the

recited composition the isocyanates of Mitani and the quinone modifiers of Parker '950.

It is well settled that, when an applicant contends that the claim language “consisting essentially of” excludes non-recited components that are disclosed in a prior art reference, the burden is on the applicant to show that the inclusion of the reference’s components materially affects the basic and novel characteristics of the applicant’s claimed composition. *In re De Lajarte*, 337 F.2d 870, 873-74 (CCPA 1964).

In the present case, Appellants have not demonstrated that the inclusion of Mitani’s isocyanates or the quinone modifiers of Parker '950 in the claimed composition would materially affect its basic characteristic as a molding compound. Appellants maintain that the inclusion of other thermoplastic components would *de facto* alter the properties of the final product, e.g., “the inclusion of isocyanates, as in Mitani, carries with it certain hazards” (App. Br. 11, last para.). However, Appellants have not established that the presence of such hazards would change the basic characteristic of the claimed composition as a molding compound. As pointed out by the Examiner, “virtually all chemicals carry with them a certain health hazard” (Ans. 7, second para.).

Furthermore, if the test was would the addition of a non-recited component change the properties of the claimed composition, any distinction between the claim language “consisting essentially of” and “consisting of” would be rendered meaningless. Manifestly, the inclusion of a component not recited in a claimed composition would necessarily change at least some property to some extent. However, such a change in a property generally does not alter the basic characteristic of the composition as, in this case, a

molding compound. Likewise, Appellants have not established that the quinone modifiers of Parker '950 would change the basic characteristic of the claim composition when added thereto.

Moreover, Appellants have not persuaded us that the exclusion of Mitani's isocyanates and the quinone modifiers of Parker '950 from a molding compound comprising an unsaturated oligomer resin and an unsaturated monomer would have been non-obvious to one of ordinary skill in the art. It is well settled that the omission of a feature disclosed by the prior art along with its attendant function is a matter of obviousness for one of ordinary skill in the art. *In re Thompson*, 545 F.2d 1290, 1294 (CCPA 1976); *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975); *In re Larson*, 340 F.2d 965, 969 (CCPA 1965). Here, Appellants have not shown that the elimination of the isocyanates of Mitani and the quinone modifiers of Parker '950 is not done without loss of the benefits associated therewith.

Appellants also have not rebutted the Examiner's conclusion that it would have been obvious for one of ordinary skill in the art to utilize the electron beam source disclosed by Mathur, Lane, or JP '675 to crosslink the compositions of Mitani and Parker '950. We are not persuaded by Appellants' argument that Mathur discloses complete polymerization and crosslinking. We are satisfied that the Examiner properly concluded that it would have been obvious for one of ordinary skill in the art to determine the dosage of radiation commensurate with the degree of crosslinking desired.

As a final point, we note that Appellants base no argument upon objective evidence of non-obviousness, such as unexpected results. Indeed, as noted by the Examiner, appealed claims 10 and 26 illustrate that Appellants contemplated the inclusion of a variety of additives in the

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molding compound other than those specifically recited in the independent claims.

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

AFFIRMED

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